

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

2007-1047, -1075, -1076
(Serial Nos. 09/754,378, 09/321,597, and 09/543,735)

IN RE CRAIG W. BARNETT, KAREN R. REISNER,
and MARK BRAUNSTEIN

Judgment

ON APPEAL from the UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

in CASE NO(S): 09/754,378, 09/321,597, and 09/543,735

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

Per Curiam (SCHALL, BRYSON, AND MOORE, Circuit Judges).

AFFIRMED. See Fed. Cir. R. 36.

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

OCT 11 2007

JAN HORBALY
CLERK

DATED OCT 11 2007

ENTERED BY ORDER OF THE COURT

Jan Horbaly

Jan Horbaly, **CERTIFIED COPY**

I HEREBY CERTIFY THIS DOCUMENT
IS A TRUE AND CORRECT COPY
OF THE ORIGINAL ON FILE.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

ISSUED AS A MANDATE: DEC 3 2007

By: *Jan Horbaly* Date: 12/3/07

NOTE: This disposition is nonprecedential.

United States Court of Appeals for the Federal Circuit

Corrected: October 30, 2007

2007-1047, -1075, -1076
(Serial Nos. 09/754,378, 09/321,597, and 09/543,735)

IN RE CRAIG W. BARNETT, KAREN R. REISNER,
and MARK BRAUNSTEIN

Kevin T. Kramer, Pillsbury Winthrop Shaw Pittman LLP, of Washington, DC, argued for appellants. With him on the brief were James G. Gatto, Scott J. Pivnick, and Robert M. Fuhrer, of McLean, Virginia.

Thomas L. Stoll, Associate Solicitor, Solicitor's Office, United States Patent and Trademark Office, of Arlington, Virginia, argued for appellee. With him on the brief were Stephen Walsh, Acting Solicitor, and Janet A. Gongola, Associate Solicitor.

Appealed from: United States Patent and Trademark Office,
Board of Patent Appeals and Interferences

CERTIFIED COPY
I HEREBY CERTIFY THIS DOCUMENT
IS A TRUE AND CORRECT COPY
OF THE ORIGINAL ON FILE.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

By: Sam H. Hill Date: 12/3/07

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CRAIG W. BARNETT and KAREN R. REISER

Appeal No. 2006-0535
Application No. 09/321,597

HEARD: APRIL 27, 2006

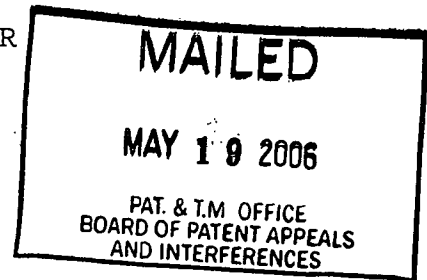
Before JERRY SMITH, BARRETT, and SAADAT, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 63-159, which constitute all the claims pending in this application.

The disclosed invention pertains to an on-line coupon distribution system. More particularly, the invention downloads coupon information from a host computer to a client computer where a paper coupon is printed by the client computer.



Representative claim 63 is reproduced as follows:

63. A method for electronic distribution of coupons over the Internet that can be printed and redeemed by a user, wherein each printed coupon includes incentive data and identification data, comprising:

receiving, electronically, at an Internet accessible location, electronic coupon data corresponding to a group of available coupons;

storing the electronic coupon data at the Internet accessible location;

establishing communication between the Internet accessible location and at least one remote user computer system to enable a user to;

(I) request access to view information regarding one or more coupons of the group of available coupons;

(ii) download coupon data management software from the Internet accessible location to the at least one remote user computer system to be used at least in connection with the printing of coupons, if the coupon data management software has not already been downloaded;

(iii) view information regarding a subset of coupons from the group of available coupons;

(iv) select for at least one coupon from the subset of coupons; and

(v) cause the at least one selected coupon to be printed by a printer associated with the at least one remote user computer system; and storing information about the at least one printed coupon.

The examiner relies on the following references:

Von Kohorn	5,227,874	July 13, 1993
Saigh et al. (Saigh)	5,734,823	Mar. 31, 1998

Appeal No. 2006-0535
Application No. 09/321,597

Claims 63-74 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claims 76-89 of copending application Serial No. 09/754,378. Claims 63-69, 71, 73 and 74 also stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-8 of U.S. Patent No. 6,321,208. Claims 63, 70, 92, 119, 124 and 125 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Finally, claims 63-159 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Von Kohorn in view of Saigh.

Rather than repeat the arguments of appellants or the examiner, we make reference to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the prior art rejection. We have, likewise, reviewed and taken into

consideration, in reaching our decision, the appellants' arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that appellants' specification supports the invention of claims 63 and 70, but does not support the invention of claims 92, 119, 124 and 125. We are also of the view that the evidence relied upon by the examiner supports the examiner's prior art rejection of claims 63-157, but does not support the rejection of claims 158 and 159. Accordingly, we affirm-in-part.

We consider first the examiner's rejection of the claims based on obviousness-type double patenting. We note that appellants have elected not to address this rejection in the appeal brief [brief, page 12]. Therefore, we sustain this rejection as a mere formality although we have not considered the technical merits of the rejection.

We now consider the examiner's rejection of the claims under the first paragraph of 35 U.S.C. § 112. With respect to claim 63, the examiner objects to the phrase "download coupon data management software..., if the coupon data management software has not already been downloaded" because the specification does

not provide support for the feature of checking if the coupon data management software has not already been downloaded [answer, page 4]. Appellants argue that the specification clearly states that the coupon data management software is downloaded when a user initially registers and is a one-time event [brief, pages 13-14].

We agree with appellants that the objected to clause of claim 63 is supported by appellants' specification. Specifically, the flow diagram of Figure 9 shows that the user receives the coupon data management software when a "YES" response is the result of the decision block "FIRST TIME ?" This "FIRST TIME" condition is sufficient to support the recitation of claim 63 that the download occurs if the software has not already been downloaded.

With respect to claim 70, the examiner objects to the phrase "...coupon is provided to the user via an electronic mail message" because the specification does not disclose utilizing an electronic mail message to provide the coupon to the user [answer, page 4]. Appellants point to several portions of the specification to support this claim recitation [brief, page 14]. The examiner responds that the portions of the specification cited by appellants do not support the objected to phrase. The

examiner asserts that the specification supports electronic transmittal such as downloading but not electronic mail [answer, page 19]. Appellants respond that an e-mail is an electronic transmittal and is supported by the specification [reply brief, page 4].

We agree with appellants that the specification supports the invention of claim 70. The examiner has drawn a distinction between electronic downloading, which is supported by the disclosure, and communication by way of e-mail, which the examiner argues is not supported by the disclosure. Although appellants do not identify any portion of the specification which specifically refers to e-mail, they argue that an e-mail is an electronic communication. Even though the specification never specifically states that coupons are sent to users by way of e-mail, we agree with appellants that the specification in its entirety would have suggested this manner of communication to the artisan. Specifically, the specification teaches that the Internet-accessible location keeps track of individual users by noting the user's on-line address. The user's on-line address is the same as the user's e-mail address. The fact that the coupon distributor has the e-mail address of each user suggests that

coupons could be delivered to the user by way of e-mail. Thus, we find that the disclosed invention contemplated the use of e-mail for the distribution of coupons.

With respect to claims 92 and 125, the examiner objects to the phrase "setting a flag to limit the number of times a particular coupon can be printed by either or both of a user or the at least one remote user computer system" because there is no support in the disclosure for limiting printing to either or both of a user or the at least one remote user computer system [answer, page 5]. Appellants cite a portion of the specification and a drawing figure which they argue supports the claimed invention [brief, page 15]. The examiner simply repeats the rejection [answer, page 20]. Appellants respond that the specification makes a distinction between a user and a remote user, and the specification further discloses limiting the printing of coupons to a user and to at least one remote user computer system [reply brief, page 4].

We will sustain the examiner's rejection of claims 92 and 125. We agree with the examiner that the specification fails to support the claimed distinction between printing by the user and printing by the at least one remote user computer system. Our reading of appellants' specification finds that it supports

limiting the printing of a coupon only by the user's computer system. We can find no portions of the specification, and appellants have cited to none, that disclose that the user is separate from the user's computer system.

With respect to claims 119 and 124, the examiner objects to the phrase "allowing the printing of an incentive a predetermined number of times" because the specification only supports limiting the printing of an incentive to one time, whereas the claim covers printing the coupon a plurality of times [answer, page 5]. Appellants argue that the specification supports this claim language because each coupon can be printed out a limited number of times (e.g. once). Appellants also argue that the claim language is supported by the specification as was agreed to by the examiner at a personal interview in a related application [brief, pages 15-16]. The examiner disputes that the claim language was found acceptable in the noted interview. The examiner reasserts that the specification only supports the predetermined number being one [answer, pages 20-21]. Appellants respond that nothing in the specification dictates that the number of times must be one. Appellants also assert an

interpretation of the claim language in which the predetermined number refers to the total number of coupons which can be redeemed by a plurality of users [reply brief, pages 6-7].

We agree with the examiner that the specification does not support the objected to phrase noted in the rejection. It appears that the objected to phrase is capable of two entirely different interpretations. The first interpretation is that each user can print each coupon a predetermined number of times. This interpretation is the one accepted by the examiner and appears to be the interpretation initially argued by appellants. This interpretation is not supported by the specification because the specification, as argued by the examiner, suggests that each coupon is to be printed only one time to avoid fraud. In the reply brief, appellants assert the second interpretation. This interpretation suggests that the predetermined number recited in the claim refers to the total number of coupons that can be printed by all the targeted users. Although this interpretation might be consistent with the claim language, it appears to be completely unrelated to anything found in the disclosure. That is, we can find nothing in appellants' specification to suggest that the total number of printed coupons is monitored to prevent fraud. Thus, this second interpretation appears to be an

interpretation recently devised by appellants in an attempt to render these claims patentable. Given these two completely different interpretations of the claim language, we decline to accept an interpretation which lacks any support or recognition in the specification as filed. Therefore, we accept the interpretation used by the examiner, and apparently by appellants initially, and conclude that the claim language so interpreted is unsupported by the specification.

Therefore, we sustain the examiner's rejection of claims 92, 119, 124 and 125, but we do not sustain the examiner's rejection of claims 63 and 70 for the reasons discussed above.

We now consider the rejection of claims 63-159 under 35 U.S.C. § 103(a) as being unpatentable over the teachings of Von Kohorn and Saigh. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive

Appeal No. 2006-0535
Application No. 09/321,597

at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose

not to make in the briefs have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

With respect to independent claims 63, 94, 158 and 159, the examiner's rejection essentially finds that Von Kohorn teaches every feature of these claims except that Von Kohorn does not explicitly disclose that the communication channel is the Internet. The examiner cites Saigh as teaching use of the Internet to transmit coupons to a user. The examiner finds that it would have been obvious to the artisan to use the Internet as taught by Saigh to transmit coupons in Von Kohorn [answer, pages 6-12].

Appellants make the following arguments: 1) that the applied prior art is non-analogous art; 2) that there is no motivation to modify the teachings of Von Kohorn with the teachings of Saigh; and 3) the collective teachings of Von Kohorn and Saigh fail to teach all of the claim elements. With respect to the first argument, appellants argue that Von Kohorn and Saigh are outside appellants' field of endeavor, which is said to be the electronic distribution of coupons in a way which reduces fraud. Appellants also argue that the applied references are not reasonably pertinent to the problems with which appellants were involved. Appellants list several problems in support of this contention

[brief, pages 17-21]. The examiner responds by citing several portions of Von Kohorn and Saigh which, according to the examiner, demonstrate that Von Kohorn and Saigh are analogous art with respect to the claimed invention [answer, pages 21-23]. Appellants respond that Von Kohorn is not primarily directed to a coupon distribution system. Appellants also respond that Von Kohorn and Saigh are not concerned with deterring fraud in print-at-home coupons or tracking user activity [reply brief, pages 8-12].

We are not persuaded by appellants' arguments that Von Kohorn and Saigh are non-analogous art. The independent claims recite a method of viewing and printing at a remote terminal user-specific incentives. There is no question that Von Kohorn prints user-specific coupons at user terminals. The fact that Von Kohorn also teaches a method for measuring the effectiveness of different stimuli on user purchases does not detract from the fact that Von Kohorn also teaches a coupon distribution system as claimed. Von Kohorn also teaches that the disclosed method is useful for preventing forged coupons [see for example, column 16, lines 55-58 and column 17, lines 10-20]. With respect to Saigh, it was cited to show that it was known to use the Internet to distribute coupons on demand. Although Saigh has much wider

applicability than the distribution of coupons, it is clearly analogous art with respect to the claimed distribution of coupons. Therefore, we find that Von Kohorn and Saigh are analogous art with respect to the claimed invention.

With respect to the second argument noted above, appellants argue that the proposed modification would render Von Kohorn unsuitable for its intended purpose and would change the principle of operation of Von Kohorn. Appellants also argue that the examiner has not properly addressed why it would have been obvious to modify the particular system of Von Kohorn to include the Internet [brief, pages 22-24]. The examiner responds that both Von Kohorn and Saigh teach the distribution of coupons to users over a network. The examiner asserts that the artisan would have been motivated to utilize the Internet in Von Kohorn to take advantage of a network that is far reaching and readily available [answer, pages 23-24]. Appellants respond that Von Kohorn is directed to a television broadcast system and teaches away from a computer network system [reply brief, page 13].

We are not persuaded by appellants' argument that there is no proper motivation for combining the teachings of Von Kohorn with the teachings of Saigh. The examiner's rejection is based on the findings that Von Kohorn teaches every element of the

claimed invention except for the use of the Internet. These specific findings will be considered below. The examiner cites Saigh for the sole purpose of teaching that it was known to use the Internet as a way to distribute incentives, such as coupons, to users of computers. Although Von Kohorn teaches the distribution of coupons to users over a television or radio broadcast network, Von Kohorn also teaches such distribution over a closed circuit network [column 10, line 37]. Von Kohorn also defines an "interactive system" as a "system for communicating from a sender to a respondent and having the capacity for allowing the sender to receive a communication, when desired, from the respondent whether by manual or electronic means" [column 9, lines 9-13]. Thus, it appears to us that Von Kohorn contemplates any interactive network as suitable for practicing his invention. We agree with the examiner that the artisan would have been motivated to use the Internet as the interactive network in Von Kohorn because the Internet has become accessible to nearly everyone who owns a personal computer and the Internet has become the wide area network of choice by such computer

users. Thus, applying the teachings of Saigh to Von Kohorn does not render Von Kohorn inoperable for its intended purpose, but only makes an additional form of communication available to the coupon distributors.

With respect to the third argument noted above, appellants simply recite the various limitations of the independent claims, and then assert with essentially no explanation or analysis that the portions of Von Kohorn cited by the examiner fail to teach the claim limitations. The examiner responds by again citing several portions of Von Kohorn which, according to the examiner, meet the individual recitations of the independent claims [answer, pages 25-40]. Appellants respond that the rejection fails to show the following elements of claim 67: 1) storing the electronic coupon data at an Internet accessible location; 2) establishing communications between the Internet accessible location and at least one remote user computer system to enable a user to request access to view information regarding one or more coupons of the group of available coupons; and 3) establishing communications between the Internet accessible location and at least one remote user computer system to enable a user to view

information regarding a subset of coupons from the group of available coupons; select for printing at least one coupon from the subset of coupons; and cause the at least one selected coupon to be printed by a printer. With respect to claims 94, 158 and 159, appellants argue that the rejection fails to show 1) storing information about coupons that are available to be downloaded over the Internet; and 2) receiving, at an Internet accessible location, a request from the personal computer for access to at least some of the stored computer information...transmitting, to the personal computer over the Internet, coupon information corresponding to the request. With respect to claims 158 and 159, appellants argue that the rejection fails to show "downloading to the personal computer a unique identifier ... wherein the unique identifier is encrypted and transmitted with the request and routines are implemented at the Internet accessible location to decrypt the unique identifier to ensure validity. Appellants support these arguments with the bare assertion that the portions of Von Kohorn cited by the examiner fail to support the examiner's findings without any explanation or analysis [reply brief, pages 13-19].

We respond to these arguments with the understanding that we have already determined that it would have been obvious to the

artisan to modify the system and method of Von Kohorn to include using the Internet as the communication channel between the coupon distributors and the coupon users. After such modification, the coupons of Von Kohorn would be sent from an Internet site to each user along with the modules necessary to control the printing of coupons. Under such circumstances, the coupon data would have to be stored at the Internet site, and the user would have to request coupons from the Internet site. Von Kohorn teaches that a user can request additional information [column 47, lines 43-45], which suggests the claimed enabling of the user to view information regarding a subset of coupons. Von Kohorn also teaches that the user can select products and request the printing and dispensing of a coupon for that product [column 2, lines 65-68], which suggests the claimed selecting for printing step and the claimed causing the coupon to be printed step. The operation as described would also entail that requests be sent from the user's computer to the Internet site for information with respect to the coupons available from the Internet site. Von Kohorn also teaches that the user can print out coupons that are uniquely coded for each coupon and user. Thus, we find that when the system and method of Von Kohorn are modified to use the Internet as taught by Saigh, each of the

elements of independent claims 63 and 94 argued by appellants is taught or suggested by the applied prior art. Therefore, we sustain the examiner's rejection of independent claims 63 and 94. Since appellants' argument with respect to each of the dependent claims consists of nothing more than an assertion without any explanation or analysis that the passages of Von Kohorn relied on by the examiner fail to render the claimed invention unpatentable, we sustain the examiner's rejection of each of the dependent claims because the examiner, in our view, at least established a prima facie case of obviousness with the findings set forth in the rejection.

With respect to independent claims 158 and 159, we agree with appellants that the examiner's rejection fails to provide evidentiary support for the transmitting of a unique identifier from the user to the Internet site with requests for coupons and such that routines are implemented at the Internet site to decrypt the unique identifier to ensure validity. Although the examiner asserts that Von Kohorn teaches encryption, the encryption taught by Von Kohorn relates to the information recorded on the printed coupon, and has nothing to do with

Appeal No. 2006-0535
Application No. 09/321,597

encrypting transmissions between the user and the Internet site. Therefore, the examiner's evidence fails to support the rejection of claims 158 and 159.

In summary, the examiner's double patenting rejection is sustained. The rejection under 35 U.S.C. § 112 is not sustained with respect to claim 63 and 70 but is sustained with respect to claims 92, 119, 124 and 125. The rejection under 35 U.S.C. § 103(a) is sustained with respect to claims 63-157, but is not sustained with respect to claims 158 and 159. Therefore, the decision of the examiner rejecting claims 63-159 is affirmed-in-part.

Appeal No. 2006-0535
Application No. 09/321,597

No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a)(1)(iv).

AFFIRMED-IN-PART

Jerry Smith

JERRY SMITH
Administrative Patent Judge

Lee E. Barrett

LEE E. BARRETT
Administrative Patent Judge

Mahshid D. Saadat

MAHSHID D. SAADAT
Administrative Patent Judge

)
)
)
)
) BOARD OF PATENT
) APPEALS
) AND INTERFERENCES
)
)
)
)

JS/pgc

Appeal No. 2006-0535
Application No. 09/321,597

Pillsbury Winthrop Shaw Pittman, LLP
P.O. Box 10500
McLean, VA 22102